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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/187,907 11/06/98 GIRARDI

V E-775

EXAMINER

TM02/0725

STEVEN J SHAPIRO  
PITNEY BOWES INC INTELLECTUAL PROP AND  
TECHNOLOGY LAW DEPT 35 WATERVIEW DR  
P O BOX 3000  
SHELTON CT 06484

HEWITT II, C

ART UNIT

PAPER NUMBER

2161

DATE MAILED:

07/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/187,907

Applicant(s)

GIRARDI ET AL.

Examiner

Calvin L Hewitt II

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

*Status of Claims*

1. Claims 1-15 have been examined.

*Response to Arguments*

2. The Applicants' are of the opinion that the Examiner's appliance of the prior art is incorrect. In particular, the Applicants' assert that the prior art doesn't teach printing an evidence of postage based on a selected fold configuration. The Examiner respectfully disagrees as Bresnan et al. teach fold selection of a document prior to printing evidence of postage (column 2, lines 21-43) and that documents are printed in accordance with the characteristics selected (e.g. fold type, print type) (abstract, lines 8-13; column 2, lines 21-43). Further, it is inherent that once a fold has been selected the system knows where on the document an evidence of postage is to be placed. Regarding the Examiner's statement, "... reply documents as part of a document ...", File teaches c and z fold reply envelopes that possess the desired characteristics (figures 5-9). Therefore, based in part on the above remarks the Examiner is rejecting claims 1-15.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara, U.S. 5,801,944 in view of Bresnan et al., U.S. Patent No. 5,873,073 and File, U.S. Patent No. 5,174,493.

As per claims 1-15, Kara teaches a method and processor based system for printing indicia onto a document (abstract, lines 1-14; figures 16A, B and 18; column 6, 10-34). Kara also teaches document folding (column/line 5/65-6/4). However, Kara does not teach of fold configuration selection. File teaches C and Z fold reply envelopes (figures 1-9). File also teaches first and second evidences of postage (figures 1, 2, 4, 7 and 9; column 4, lines 34-44; column 5, lines 42-58). Although, File does not disclose half-folds, the Examiner takes Official Notice that document fold configurations are well known in the art of document and mail processing. And, that these folds can be applied according to the message that a user would like to convey to the document or mailer recipient. Bresnan et al. teach a mail piece production system. In particular, Bresnan et al. discloses a method and system for producing a finished mail piece that:

- allows users to select first and second fold configurations (column 8, lines 40-62; column/line 9/63-10/8)
- allows users to select amongst half, C or Z folds (column 8, lines 56-62; column 10, lines 5-7)

- identifies to the processor the configuration selections and creating the document the document (column 2, lines 21-50; column 3, lines 15-56; column 8, lines 40-62; column/line 9/63-10/8)
- allows a user to input secondary information such as paper size (column 8, lines 60-62)
- document printing, metering, return envelopes and inserts (abstract, lines 4-17; column/line 9/63-10/26; column 11, lines 20-38; column/line 18/61-19/12)
- allows users to select simplex or duplex printing (column 2, lines 24-27; column 8, lines 40-50)

Therefore, it would have been obvious to combine the teachings of Kara, File and Bresnan et al. Mailers that include reply documents as part of a document or as inserts are well known. Some of these reply mailings have postage already accounted for by the mailer source (e.g. "No postage necessary..."). Using the system of Kara a user can print a first postage indicia on the original document and a second indicia on the reply document. File teaches that a "reply" can have a plurality of fold configurations ('493, column 1, lines 40-43). By applying the configuration selection of Bresnan et al., a user can accommodate multiple configurations and print indicia according to fold (e.g. c, z and half) and print specifications (e.g. simplex or duplex) ('944, figures 16A and B; '073, abstract, lines 8-13; column 2, lines 21-43).

*Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Taylor teaches a mailer with return envelope
- Sauerwine et al. teach a single sheet Z-fold mailer
- Harvey et al. teach encrypted postage indicia printing for mailer inserting systems
- Harman et al. teach a document control page interface.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The examiner can normally be reached on Monday-Friday from 8:30 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to"

Commissioner of Patents and Trademarks

C/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or:

(703) 308-5397 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

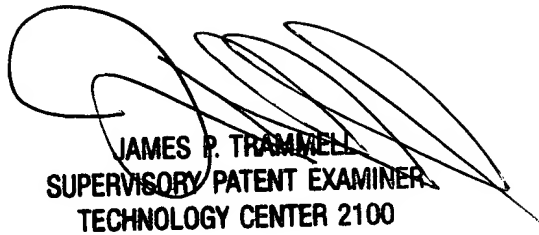
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Calvin Loyd Hewitt II

July 18, 2001



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100